

**IN THE DRAWINGS**

Applicant acknowledges that the drawings, as filed on November 21, 200, are accepted by the Examiner.

## REMARKS

Applicant acknowledges and appreciates the Decision of the Panel to **reopen prosecution** on the merits of Applicant's arguments Presented in the Appeal Brief filed August 20, 2007. Applicant acknowledges that prosecution has been reopened and a non-final office action has been issued, presenting new grounds of rejection. Applicant chooses to exercise the option of filing a reply under 37 C.F.R. 1.111.

Claims 1-35 are pending in the application. Claims 1-6, 8-18, 20-28 and 30-35 are rejected. Claims 7, 19 and 29 are objected to as being dependent upon a rejected base claim.

### *Claim Rejection – 35 U.S.C. 103*

In the present Office Action, the Examiner rejected claims 1-2, 9, 23-24, 31-32 and 34 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,802,305 (**McKaughan**) in view of U.S. Patent No 5,748,688 (**Kim**). Applicant respectfully traverses this rejection.

**McKaughan**, which is the primary reference, does not disclose or make obvious several elements of claim 1 of the present invention, and **Kim** does not make up for the deficit of **McKaughan**. **McKaughan** refers to a computer network that contains a plurality of interconnected computers, wherein a network interface card of sleeping computers detects an incoming packet and compares the incoming packet to a list of packets stored on the network interface cards. **McKaughan** then compares the received packet to a list of packets on the card and provides a wake-up sequence of a remote computer (see column 6, lines 43-64 of **McKaughan**). However, **McKaughan** does not disclose detecting the size of the received set of data signals as called for by claim 1 of the present invention. **McKaughan** merely discloses detecting an incoming packet over a network and filtering the incoming packet with a

comparison mask. This does not make obvious the element of detecting the size of the received set of signals or other elements of claim 1. *McKaughan* does not disclose detecting the size of the received set of signals. Therefore, Appellant respectfully asserts that among other elements, *McKaughan* simply does not disclose or make obvious the element of detecting the size of the received set of signals when determining whether to wake up the computer.

*McKaughan* simply does not disclose detecting the size of the received set of data signals in the context of determining whether the received data signal should be received by the host circuit and waking up the whole circuitry as called for by claim 1 of the present invention. *McKaughan* merely refers to filtering the incoming packet, comparing the resulting filtered incoming packet to the corresponding packet in a list stored on a network interface card and making a decision whether to wake up the computer. See Figure 4 and col. 8, lines 45-47, col. 9, lines 3-13 of *McKaughan*. *McKaughan* does not disclose detecting the size of the received set of signals when determining whether to wake up the computer, which is an element called for by claim 1. Further, *Kim* does not make up for the deficits of *McKaughan*.

In the Office Action dated November 28, 2007, the Examiner admits that *McKaughan* does not disclose detecting a size of the received set of data signals to use as a factor for decoding the data. Appellant respectfully asserts that the Examiner is correct in the statement but, further, *McKaughan* does not disclose or make obvious other elements of claim 1 of the present invention. Regarding detecting the size of the data received, *Kim* does not make up for this deficit. The Examiner simply point to the Abstract of *Kim* to argue obviousness of the element of detecting a size of the received set of data signals to use as a factor for decoding the data. However, neither this portion of any other portion of discloses detecting a size of the data to use as factor for decoding the data.

*Kim* discloses that the detection of the size of the data is made to perform a bit pattern detection process, and not for decoding purposes. See Abstract, col. 2, line 55-col. 3, line 8; Fig. 2. The size of the data is detected to determine the position of the bit pattern to be matched. *Id.* However, *Kim* does not disclose detecting the size of the data for any type of decoding purpose. In fact, *Kim* discloses that the pattern matching function, in which size of the data is detected, is a separate function from performing a decoding function. *Kim* explicitly discloses that after the input data stream is converted from serial to parallel format, it is sent to two different functions: a pattern matching function (in which the size of the data is detected)—“bit pattern detector” 200, and a decoding function—“Code Table” 330. See Fig. 3; col. 5, line 53-col. 6, line 4. Therefore, *Kim* explicitly discloses that detection of the size of the data is not used as any type of a factor for decoding the data, but is simply used to performing pattern matching. Further, *Kim* explicitly makes clear that the pattern matching function is different from the decoding function. Therefore, *Kim* fails to make obvious at least the element of detecting a size of the received set of data signals to use as a factor for decoding the data. In fact, *Kim* affirmatively indicates that the size of the data is not used for any type of decoding purposes. As noted above, the Examiner had indicated that this element is not disclosed or made obvious by *McKaughan*. Therefore, *Kim* does not provide subject matter that makes obvious any element that is also not made obvious by *McKaughan*. Accordingly, the combination of *Kim* and *McKaughan* does not make obvious all of the element of claim 1 of the present invention. Further independent claims 23, 32, and 34 also call for various method and apparatus limitations similar to the subject matter described above. The arguments relating to claim 1 also apply to claims 23, 32, and 34. Therefore, all of the elements of independent claim 1, 23, 32, and 34 are not made obvious by

**Kim, McKaughan**, or their combination and thus, claims 1, 23, 32, and 34 are allowable for at least the reasons cited herein.

Independent claims 1, 23, 32 and 34 are allowable for at least the reasons cited herein. Additionally, dependent claims 2-9, 24-31, and 35, which respectively depend from independent claims 1, 23, and 34 are also allowable for at least the reasons cited herein.

Further, without using improper hindsight reasoning, those skilled in the art would not combine **Kim** and **McKaughan** in such a manner as claimed by the present application. Applicants respectfully assert that **McKaughan**, **Kim**, and/or their combination do not teach or disclose all of the elements of claims 1, 23, 32, and 34 of the present invention. In order to establish a prima facie case of obviousness, the Examiner must consider the following factors: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. MPEP § 2143 (2005) (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)). In making an obviousness rejection, it is necessary for the Examiner to identify the reason why a person of ordinary skill in the art would have combined the prior art references in the manner set forth in the claims. *KSR Int'l Co. v. Teleflex, Inc.*, at 14, No. 04-1350 (U.S. 2007). Applicants respectfully submit that the Examiner has not met this burden. In fact, as illustrated herein, **McKaughan** and **Kim** are incompatible, and consequently those skilled in art would not combine them and make all of the elements of claims of the present invention obvious. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established in rejecting claims 1-2, 9, 23-24, 31-32 34 and 35.

**McKaughan** refers to a computer network that contains a plurality of interconnected computers, wherein a network interface card of sleeping computers detects an incoming packet and compares the incoming packet to a list of packets stored on the network interface cards. In contrast **Kim** is directed to performing a pattern matching function. **Kim** does not even mention the terms sleep or sleep mode. The Examiner uses improper hindsight reasoning to combine **McKaughan** and **Kim** in the manner set forth in the claims. Further, the Examiner failed to identify any reason why those skilled in the art would combine **McKaughan** and **Kim** in the manner set forth in the claims. *KSR Int'l Co. v. Teleflex, Inc.*, at 14. Accordingly, the Examiner failed to establish a *prima facie* case of obviousness has not been established in rejecting claims 1-2, 9, 23-24, 31-32 34 and 35. Therefore, claims 1-2, 9, 23-24, 31-32 34 and 35 are allowable for at least the reasons cited herein.

Additionally, claims 3-6, 8, 10-18, 20-22, 25-28, 30, 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over **McKaughan**, in view of **Kim** and further in view of U.S. patent No. 4,516,201 (**Warren**). Applicant respectfully traverses this rejection.

Contrary to the Examiner's assertions in the Office Action dated November 28, 2007, the combination of **McKaughan** and **Kim** do not teach, disclose or suggest all of the elements of the independent claims of the present invention. The deficit of **McKaughan** and **Kim** are not made up for by **Warren**. Appellant respectfully asserts that even with the use of **Warren**, the combination of **McKaughan**, **Warren** and **Kim** would still not disclose all of the elements of claims of the present invention.

The deficit of **McKaughan** and **Kim** is not made up for by **Warren**. For example, **Warren** discloses a host 12 that passes data transmitted by a data link 14, which is examined by a controller 10. See col. 6, lines 25-36. However, the system disclosed by **Warren** does not check

for the size of the data signals; it merely converts the received signal from parallel to a serial format. *See* col. 6, lines 25-36. **Warren** merely discloses a link 14 that presents the serial string as parallel words to the host 12. *See* col. 6, lines 37-48. **Warren** discloses status information regarding the data link 14 being provided to the host 12 to take action, however **Warren** does not disclose any status information regarding the size of the received data signal as called for by the claims of the present invention.

The only reference to memory size in **Warren** relates to the limitation of the host system. **Warren** discloses that the host system may be joined via the controller where memory size, data handling capacity, or speed limitations would otherwise preclude their joining to a data link 14. *See* col. 7, lines 7-17. However, this does not relate to receiving data signals and detecting the size of the received signals and performing the coding and various other steps for waking up a host circuitry as called for by the claims of the present invention.

**Warren** does not disclose a wake-up sequence called for by the claims of the present invention. **Warren** is generally directed towards the data communication link such as a modem providing a queue for data in a controller. This is vastly different from the disclosure of **McKaughan**, which is directed towards a wake-up sequence. Therefore, without impermissible hindsight, one of ordinary skill in the art would not combine the disclosure of **McKaughan** and **Warren** to make obvious any of the claims of the present invention. Therefore, it would be improper hindsight to combine the teachings of **Warren** with **McKaughan** to make obvious any claim of the present invention. However, even if **McKaughan**, **Kim**, and **Warren** were combined, as described above, the deficits of **McKaughan** are not made up for by **Warren** or **Kim**; including the fact that neither **McKaughan**, **Kim**, **Warren**, nor their combination disclose or make obvious detecting the size of the received set of data signals in the context of decoding

the receiving signals, and waking up the host circuitry from a sleep mode, as called for by the claims of the present invention.

For at least the reasons cite above, combining *Warren*, with the disclosure of *Kim* and/or *McKaughan*, would still not result in disclosing or making obvious all of the elements of any of the claims of the present invention. Therefore, claims 3-6, 8, 10-18, 20-22, 25-28, 30, 33, and 35, are not taught, disclosed, or made obvious by *McKaughan*, *Kim*, *Warren*, or their combinations. Accordingly, claims 3-6, 8, 10-18, 20-22, 25-28, 30, 33, and 35 are allowable for at least the reasons cited above.

Appellant respectfully asserts that it is impermissible hindsight because the Examiner's reasoning is not based upon knowledge that was available to those skilled in the art without having read the present disclosure. *Warren* is directed towards data communication link whereas *McKaughan* is directed towards a wake up sequence. There is no disclosure in *McKaughan* and *Warren* that would prompt those skilled in the art to combine them to make obvious all of the elements of claims of the present invention. The Examiner does not provide sufficient evidence to support or point to any disclosure in either *Warren* or *McKaughan* that would direct one skilled in the art to combine them to make obvious all of the elements of claims of the present invention. Again, the Examiner has failed to identify the reason why those skilled in the art would have combined *Warren* with *McKaughan* and/or *Kim* in the manner set forth in the claims. *KSR Int'l Co. v. Teleflex, Inc.*, at 14. Appellant maintains that those skilled in the art, without using impermissible hindsight reasoning, would not combine *Warren*, *McKaughan* and/or *Kim* to make obvious any of the claims of the present invention. Further, as described above, *McKaughan* and *Kim* are not compatible in the manner used by the Examiner to reject that claims of the present application. Hence, there is insufficient evidence to support any



contention that any suggestion or motivation exists to prompt one of ordinary skill in the art to modify the reference or to combine reference teachings, which is a requirement to show a *prima facie* case of obviousness. *In re Vaeck*, 947 F.2d 488; *KSR Int'l Co. v. Teleflex, Inc.*, at 14. Further, as described above, *McKaughan*, *Kim*, and *Warren*, alone or when combined, do not teach or suggest all the claim limitations, which is a requirement to establish a *prima facie* case of obviousness. *Id.* Accordingly, the Examiner erred in rejection the claims of the present invention. Accordingly, claims 1-35 are allowable for at least the reasons cited herein.

Appellant acknowledges and appreciates that the Examiner has indicated that claims 7, 19 and 29 contain allowable subject matter. In light of the arguments provided herein, Appellant respectfully asserts that all claims of the present invention are also allowable.

Applicant respectfully asserts that in light of the amendments and arguments provided by Applicant throughout the prosecution of the present application, all claims of the present application are now allowable and, therefore, request that a Notice of Allowance be issued.

Reconsideration of the present application is respectfully requested.

If for any reason the Examiner finds the application other than in condition for allowance, the **Examiner is respectfully requested to call the undersigned attorney** at the Houston, Texas telephone number (713) 934-4069 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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